UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,416	11/26/2003	Amit Bagga	503048-A-01-US (Bagga)	2635

47702 7590 03/28/2007 RYAN, MASON & LEWIS, LLP 1300 POST ROAD SUITE 205 FAIRFIELD, CT 06824	**EXAMINER** WILLIAMS, KENT L

ART UNIT	PAPER NUMBER
2139	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

Office Action Summary	Application No.	Applicant(s)
	10/723,416	BAGGA ET AL.
	Examiner	Art Unit
	Kent L. Williams	2139

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _11 November 2003_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-25_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-25_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _17 March 2004_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

2.   Claims 5, 6, 17 and 18 recite the limitation "answers to user selected questions"

in the second line of each claim. There is insufficient antecedent basis for this limitation

in the claim in their respective independent claims.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

4.   Claims 12 and 24 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter. The claims recite that a "topic is

selected based on psychological insights." Per page 11, lines 5-20 of the applicant's

specification, "psychological insights" is not defined to have a tangible result, as it is a

completely subjective analysis. There is no evidence that a tangible or concrete result

(e.g., repeatable) will follow deriving questions that the user can "easily remember"

based on "psychological insights." This is evidenced by the use of the descriptor "many

people" regarding useful results. The percentages given regarding "many people" are

also subjective (e.g., vary by each survey).

5.   Claim 25 is rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. "A machine readable medium" claimed to

contain "one or more programs" is still a program per se, which could be correlated with

non-functional descriptive material (outlined as nonstatutory). Typically, computer-

executable code embodied on a machine-readable medium that causes the machine to

perform a *method* when executed would be considered statutory, but an article of

manufacture comprising machine-readable medium is to claim the medium itself and not

just the method.

Claim Rejections -·35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7.   Claims 1-25 are rejected under 35 U.S.C. 102(b) as being anticipated by

Kanevsky et al. (U.S. Patent No. 5,774,525).

Claim 1. A method for generating a password for a user, comprising [Column 4,lines 14-19]:
presenting said user with at least one topic [Column 6, lines 11-15; categories is equivocal to "topics"];
receiving one or more personal details from said user associated with said at least one topic [column 2, lines 8-22];
ensuring that a correlation between said user and said one or more personal details does not violate one or more predefined correlation rules [Column 2, lines 27-40; "minimum amount of information contained in the question" is equivocal to "minimizing correlation between user and information requested," which is a form a correlation and is the exact correlation claimed by this claims dependent claims]; and
recording said one or more personal details as a password for said user [Columns 10

and 11, lines 65-67 and 1-5].

Claim 2. The method of claim 1, further comprising the step of receiving a reminder associated with each of said one or more personal details [Column 3, lines 26-33; A question is inherently a "reminder" to the answer, where the other case of such a system would be password/authentication data entry without a question or other information presented beforehand].

Claim 3. The method of claim 1, further comprising the step of presenting said user with a plurality of topics and receiving a user selection of said at least one topic [Column 4, lines 43-45; The Examiner finds that asking a question based on another question teaches 'asking a user for a topic to ask a question' as presented by the instant application].

Claim 4. The method of claim 1, wherein said correlation rules are based on said at least one topic [Column 6, lines 35-45; Topics is equivocal to Categories, and the data is clearly correlated by the type of data of the category/topic].

Claim 5. The method of claim 1, wherein said one or more predefined correlation rules ensure that answers to user selected questions cannot be qualitatively correlated with said user [Column 2, lines 25-40; minimum qualitatively user-correlated data intentionally absent].

Claim 6. The method of claim 1, wherein said one or more predefined correlation rules ensure that answers to user selected questions cannot be quantitatively correlated with said user [Column 2, lines 25-40; Same reasoning as claim 5; <u>AND</u> Column 6, lines 40-44; By combining the quantitative user-correlated data through mathematical operations, it is not longer possible to correlate said data to the user (owner)].

Claim 7. The method of claim 1, further comprising the step of sending said one or more personal details to said user as a reinforcement of said password [Column 3, lines 26-33; A question inherently contains "personal details" – same reasoning as claim 2].

Claim 8. The method of claim 1, wherein said one or more personal details are related to a personal fact from a past of said user [Column 6, lines 10-28].

Claim 9. The method of claim 1, wherein said one or more personal details are related to an experience of said user in connection with a public event [Column 6, lines 10-28].

Claim 10. The method of claim 1, wherein said one or more personal details are related to an experience of said user in connection with a private event [Column 6, lines 10-28].

Claim 11. The method of claim 1, wherein said one or more personal details can be tested during a verification phase using one or more of Boolean, multiple choice, numeric or textual queries [Column 9, lines 25-40; Where the 'second question' is Boolean (having a random probability of one-half) and the first and third questions represent alphanumeric and/or multiple choice answers].

Claim 12. The method of claim 1, wherein said at least one topic is selected based on psychological insights [Column 5, lines 60-65; It can be said that "psychological insight" can be wrought through correlation between answers of questions].

Claim 13.
An apparatus for generating a password for a user, comprising:
a memory; and

at least one processor, coupled to the memory, operative to:

present said user with at least one topic;

receive one or more personal details from said user associated with said at least one topic;

ensure that a correlation between said user and said one or more personal details does not violate one or more predefined correlation rules; and

record said one or more personal details as a password for said user [Rejected per claim 1 – same limitations].

Claim 14. The apparatus of claim 13, wherein said processor is further configured to receive a reminder associated with each of said one or more personal details [Rejected per claim 2].

Claim 15. The apparatus of claim 13, wherein said processor is further configured to present said user with a plurality of topics and receive a user selection of said at least one topic [Rejected per claim 3].

Claim 16. The apparatus of claim 13, wherein said correlation rules are based on said at least one topic [Rejected per claim 4].

Claim 17. The apparatus of claim 13, wherein said one or more predefined correlation rules ensure that answers to user selected questions cannot be qualitatively correlated with said user [Rejected per claim 5].

Claim 18. The apparatus of claim 13, wherein said one or more predefined correlation rules ensure that answers to user selected questions cannot be quantitatively correlated with said user [Rejected per claim 6].

Claim 19. The apparatus of claim 13, wherein said processor is further configured to send said one or more personal details to said user as a reinforcement of said password [Rejected per claim 7].

Claim 20. The apparatus of claim 13, wherein said one or more personal details are related to a personal fact from a past of said user [Rejected per claim 8].

Claim 21. The apparatus of claim 13, wherein said one or more personal details are related to an experience of said user in connection with a public event [Rejected per claim 9].

Claim 22. The apparatus of claim 13, wherein said one or more personal details are related to an experience of said user in connection with a private event [Rejected per claim 10].

Claim 23. The apparatus of claim 13, wherein said one or more personal details can be tested during a verification phase using one or more of Boolean, multiple choice, numeric or textual queries [Rejected per claim 11].

Claim 24. The apparatus of claim 13, wherein said at least one topic is selected based on psychological insights [Rejected per claim 12].

Claim 25. An article of manufacture for generating a password for a user, comprising a machine readable medium containing one or more programs which when executed implement the steps of:

one topic;

presenting said user with at least one topic;

receiving one or more personal details from said user associated with said at least

ensuring that a correlation between said user and said one or more personal details
does not violate one or more predefined correlation rules; and.
recording said one or more personal details as a password for said user [Rejected per
claims 1 and 13 – same limitations].

Double Patenting

8.   The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees.   A nonstatutory
obviousness-type double patenting rejection is appropriate where the conflicting claims
are not identical, but at least one examined application claim is not patentably distinct
from the reference claim(s) because the examined application claim is either anticipated
by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140
F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29
USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.
1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422
F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163
USPQ 644 (CCPA 1969).
       A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d)
may be used to overcome an actual or provisional rejection based on a nonstatutory
double patenting ground provided the conflicting application or patent either is shown to
be commonly owned with this application, or claims an invention made as a result of
activities undertaken within the scope of a joint research agreement.
       Effective January 1, 1994, a registered attorney or agent of record may sign a
terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with
37 CFR 3.73(b).

9.   Claims 1-3, 7, 11, 13-15,19 and 23 provisionally rejected on the ground of

nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4,

5-7, 10-12, 17-20, 22, 27 and 30-33 of copending Application No. 10/674,288. Although

the conflicting claims are not identical, they are not patentably distinct from each other

because both sets of claims are drawn to a method for generating a user password

based on answers to questions (where the copending application claims "hints" that

would invoke an answer, just as the "topics" of the instant application – both

applications produce the same function by the same means). The most pertinent claim correlations, given by the instant claims to the copending claims, are: Claims 1, 13 and 25 to claims 1, 17-19, 27 [Generating a password based on answers from questions presented to a user]; Claims 2-4, 7, 8, 11, 14-16, 19, 20 and 23 to claims 4-7, 10, 12, 21, 22, 28, 30-33 [password based on user input and reinforced by memory "jogging"].

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10.   Claims 1, 5-7, 9-10, 13, 17-19, 21-22 and 25 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6, 15-16, 21-24 and 26-27 of copending Application No. 10/815,191. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to forming a password with low correlation to said user. The most pertinent correlation between the claims of the instant application to the copending application are: Claims 1, 13 and 25 to 1 and 21 [forming a password with low correlative values]; Claims 5-7, 9-10,17-19 and 21-22 to claims 2-4, 15-16, 22-24 [Defining the low correlation between said password and said user].

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11.   Claims 1, 13 and 25 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 24 and 39 of

copending Application No. 10/626,482. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to forming a user password based on answers of predetermined questions. The claims given match one-to-one respectively.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12.   Claims 1, 13 and 25 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 22 and 32 of copending Application No. 10/626,483. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to forming a user password based on answers of predetermined questions. The claims given match one-to-one respectively, as well.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kent L. Williams whose telephone number is 571-270-1376. The examiner can normally be reached on Mon-Fri 7:00-4:30 with Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kent Williams
3/21/2007